

Appl. No. 09/558,924

REMARKS

Claims 21-22, and 43-49 are pending in the present application. Claim 21 has been amended in this Response. The remarks below support applicant's assertion that these claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

35 U.S.C. § 101

Initially, in the Office Action, claims 21-22 and 43-49 were rejected under 35 USC 101 as not producing a "concrete, tangible, and useful result." Applicant has amended claim 21 to address this rejection, and traverses this rejection as it is applied to claim 49.

Claim 21 and claims depending therefrom

In support of finding claim 21 non-statutory, the Office Action states that the final result (i.e., the derivation) is not applied or even made available for any other entity. While applicant disagrees that the law requires such in order to find a claim statutory, applicant has amended claim 21 to add the limitation that the derivation is made available to other processes.

Applicant has previously argued that the claimed "deriving, using said recorded information, whether said first addressed content and said second addressed content were displayed on said computing device during overlapping time periods" (claim 21, lines 17-19) is analogous to the step of determining a billing amount for a telephone bill, the later being an approved result in AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). The Examiner appears to read into the AT&T decision that the billing amount is actually used in the claims of the patent in suit. However, a careful

Appl. No. 09/558,924

reading of the claim at issue in AT&T shows that the billing amount is merely determined. No specific use beyond this determination is made. Thus, applicant reasserts that even without the amendment to claim 21 made herein, the present claim is analogous to the claim in AT&T, and therefor should be considered statutory.

Furthermore, the Examiner concludes that since the *final result* is a derivation, claim 21 is non-statutory (Office Action, para. 12, emphasis in original). However, it is not simply the final result which determines statutory subject matter. Each element or step of a claim forms a facet of the overall claim, and it is this overall claim that must be judged against wording and interpretations of 35 U.S.C. §101. "In determining the eligibility of [a] claimed process for patent protection under §101, the claims must be considered as a whole." Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). See also the PTO's own "Examination Guidelines for Computer-Related Inventions" which state that any claim analysis must include "identifying and evaluating each claim limitation" (Part II, C, emphasis added).

Claims 22 and 43 through 48 each depend, directly or indirectly, on claim 21, and therefore contain all limitations of claim 21. Accordingly, as applicant asserts that claim 21 meets the requirements of 35 U.S.C. §101, applicant asserts for the same reasons that claims 22 and 43 through 48 meet those requirements. Reconsideration and removal of this ground of rejection of claims 21-22 and 43-48 is respectfully requested.

Claim 49

In addition to the above, as regards claim 49, applicant reiterates that that claim is directed to a storage medium having stored thereon a number of functional software objects. As such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, "[w]hen functional

Filed: February 9, 2007

Page 8 of 14

Response to 11/09/2006 Office Action

Appl. No. 09/558,924

~~descriptive material is recorded~~ on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory...." Furthermore, since claim 49 provides information to a server "for determining at least whether said information comprising said first software object and information comprising said second software object were displayed on a computing device during overlapping time periods", a useful, concrete and tangible result is provided. Thus, claim 49 satisfies the requirements of 35 U.S.C. 101. Reconsideration and removal of this ground of rejection of claim 49 is respectfully requested.

35 U.S.C. § 103

Claims 21-22 and 43-49 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Furst (USP 6,297,819) in view of Himmel (USP 6,275,854), Merriman et al. (USP 5,948,061), and Cooper (USP 6,662,341). Applicant respectfully traverses this rejection as detailed below.

As a brief summary and reminder, the present invention is directed to a method of keeping track of a user's interactions with addressed content such as may be obtained from web sites via the Internet. The addressed content, while capable of being displayed by a web browser application, is actually rendered independent of such a web browser application to allow a content provider to side-step the constraints on presentation of content imposed by traditional web browser user interfaces. Importantly, the addressed content includes "at least a portion of a definition" of a frame in which the content is displayed. This allows a content provider to specify the shape, style, and other attributes of the frame in which its content is displayed. Thus, a content provider may provide for the display of specified content without the constraint that such content be displayed within a typical browser window.

Filed: February 9, 2007

Page 9 of 14

Response to 11/09/2006 Office Action

Appl. No. 09/558,924

With that introduction, we turn to the rejections and the references cited in support thereof. Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Furst in view of Himmel, Merriman and Cooper. Paraphrasing the Office Action, Furst is cited to teach: (i) displaying addressed content in a frame at least in part outside of a window of a web browser program, and (ii) wherein the addressed content comprises at least a portion of a definition of the frame in which the content is displayed. Himmel is cited to teach recording the starting time and ending time of the display of content. Merriman is cited to teach deriving whether first and second content were display at overlapping time periods. Furst, Himmel, and Merriman have been discussed by applicant in its previous response. Cooper is cited to teach rendering content independently of a web browser program. It is asserted in the Office Action that the combination of these references teach all elements of claim 21. Applicant respectfully traverses this rejection.

Claim 21 recites that "the first addressed content comprises at least a portion of a definition of the first frame" (claim 21, lines 6-7) and "the second addressed content comprises at least a portion of a definition of the second frame" (claim 21, lines 12-13). That is, the addressed content carries with it at least a portion of the definition of the frame within which the content is displayed. While the Office Action makes the assertion that this element is shown by Furst, there is no specific citation in the Office Action to where in the Furst reference this is disclosed. It is beyond argument that a *prima facie* case of obviousness requires that each element of the rejected claim be taught or suggested by the cited reference(s). The burden to make such a *prima facie* case of obviousness is on the Patent Office. In re Oeriker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, since there is no citation of where Furst, or any of the cited references, teach the element of addressed content comprising at least a portion of a definition of the frame, no such *prima facie* showing of obviousness has been made.

Appl. No. 09/558,924

Indeed, applicant asserts that the Furst-reference, as well as each of the other cited references, fails to teach or suggests this element, and that therefore no *prima facie* case of obviousness can be made in relying on the cited references. Therefor, applicant asserts that claim 21 is patentably distinct from Furst as well as the combination of Furst, Himmel, Merriman, and Cooper, taken alone or together.

Furthermore, the office action makes a number of assertions that it would be obvious to one of ordinary skill in the art to combine the various references. Applicant respectfully disagrees. The first such assertion occurs at page 4, lines 7-11, of the Office Action, at which it is stated "It would have been obvious to one of ordinary skill in the art to combine the teachings of Himmel with Furst in order to provide information to the third-party tool administrators information (sic) regarding which tools are open with what other tools..." (See also, page 4, line 21 - page 5, line 2; and, page 5, line 6-10) However, for such a synergistic combination to be effective as prior art against applicant's claims, there must be some suggestion, either in the references themselves or in the general knowledge of the art, to which the examiner can point to support making the combination. In re Dillon, 919 F. 2d 688, 692-93, 18 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992); In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In no instance of the assertions of the obviousness of the various combinations employed in the Office Action has there been any reference to such specific suggestions to combine, either in the references themselves nor as might be found in the general knowledge of the art. Rather, merely conclusory statements about what the combination of references teach are presented. Again, the burden is on the Examiner in the first instance to demonstrate the suggestions to combine or modify the various references. In re Oeriker, supra. See also Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990).

Filed: February 9, 2007

Page 11 of 14

Response to 11/09/2006 Office Action

Appl. No. 09/558,924

~~This burden has not been met.~~ Accordingly, under well established case law, no *prima facie* case of obviousness has been made in the combination of references.

With regard to claim 49, that claim includes the limitation "the information includes instructions for ~~invoking~~ a first computing device resident process executable independent of a Web browser" (claim 49, lines 5-6 and 12-13). That is, the instructions are able to invoke a process without interaction with (i.e., "independent of") a Web browser application. The Office Action points to no portion of any of the cited references which teaches this limitation. Indeed, there are numerous statements in Furst suggesting a dependence on a web browser, such as "[t]he discussion tool user interface is defined by a discussion tool home page, which is displayed in a client discussion tool window by the client's embedded browser...the discussion tool user interface is defined by a web page." (Furst, col. 9, lines, 12-16, emphasis added.) See also the windows (or frames) illustrated in Figs. 4A and 5 from Furst, in which one consistently finds the icon for Internet Explorer in the upper right corner, implying the dependence on an underlying browser program.

Likewise, Himmel and Merriman track a user's interaction with objects which must be programmed for, rendered with, and displayed completely within a typical web browser program. For example, Himmel describes a method of tracking the viewing of advertisements A-D 606-612 included in web page 194 (col. 8, lines 18-18). Likewise, Merriman tracks the click-through of objects such as banner advertisements "provided to the user's browser." (Merriman, col. 3, lines 53-56.) Thus, in both of these references, the tracked objects are clearly not "rendered independently from a Web browser program" as claimed in claim 21.

The referenced introduced in the Office Action, USP 6,662,341 (Cooper), teaches a system for the creation and operation of applications authored in HTML and scripting

Appl. No. 09/558,924

programming languages. Cooper teaches that a user may author an application (as opposed simply to content) in HTML or a scripting language. In running the application, a determination is first made as to whether the file is an application. If it is an application, a window is opened, the file is parsed and then rendered in the opened window. In the "local" implementation of the invention disclosed by Cooper, while the window is separate from the browser window, a browser is employed to parse the HTML allocation file. "In a preferred embodiment, using the Internet Explorer, this parsing is accomplished using several processes that communicate with each other and perform various aspects of the processing." (Cooper, col., 7, lines 32-37). In the remote embodiment of Cooper, execution of the HTML application is by way of a hyperlink to the browser (Cooper, col. 7, lines 50-53, col. 8, lines 3-4, etc.) That is, while an HTML application is rendered in a window separate from the browser, according to the disclosure of Cooper that application is not executable independent of a Web browser.

Accordingly, Furst, Himmel, Merriman, and Cooper, alone and in combination depend upon a Web browser application for execution. Therefore, even if the combination of those references were permissible, such a combination could not disclose or suggest each limitation of claim 49. According to the above-cited case law, if the references fail to teach each element of the claim against which they are cited, no *prima facie* case of obviousness has been made. For this reason, applicant respectfully traverses the rejection of claim 49 in light of Furst, Himmel, Merriman, and Cooper, and respectfully requests reconsideration and allowance of the that claim.

Appl. No. 09/558,924

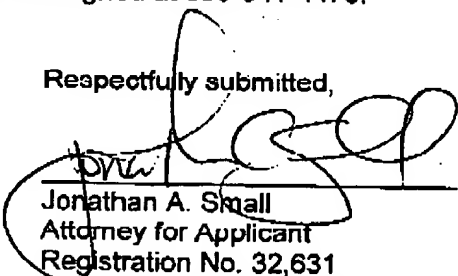
Conclusion

In summary, applicant has amended claim 21 to address the rejection of that claim, and the claims which depend therefrom under 35 USC §101. Applicant traverses the rejection of claim 49 under 35 USC §101. Applicant traverses the rejections of claims 21-22 and 43-49 under 35 USC §103, first because not every limitation in those claims is disclosed by the proposed combination of references, and second because the proposed combination of reference is improper. Therefore, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,


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Filed: February 9, 2007

Page 14 of 14

Response to 11/09/2006 Office Action